

REMARKS

The present Amendment amends claims 1, 2, 7-9, 12, 14, 16, and 18-22, leaves claims 10, 11, 13, and 15, unchanged, cancels claims 3-6, 17, and 23-32, and adds new claims 33-36. Therefore, the present application has pending claims 1, 2, 7-16, 18-22, and 33-36.

Claim Objections

The Examiner objected to claim 22, citing informalities. Where appropriate, Applicants have amended claim 22. Therefore, this objection is overcome and should be withdrawn.

35 U.S.C. §112 Rejections

Claims 7, 20, 23, 26, 27, 30, and 32 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As indicated above, claims 23, 26, 27, 30, and 32 were canceled. Therefore, this rejection with respect to claims 23, 26, 27, 30, and 32 is rendered moot. With respect to the rejection of the remaining claims 7 and 20, this rejection is traversed for the following reasons. Applicants submit that claims 7 and 20, as now more clearly recited, fully comply with the requirements of 35 U.S.C. §112, second paragraph. Therefore, this rejection is overcome and should be withdrawn.

Claim 19 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps or elements, such omission amounting to a gap between the steps or between the elements. This rejection is traversed for the

following reasons. Applicants submit that claim 19, as now more clearly recited, complies with the requirements of 35 U.S.C. §112, second paragraph. Therefore, this rejection is overcome and should be withdrawn.

35 U.S.C. §102 Rejections

Claims 1-10, 17, 18, 20, 21, and 23-32 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,884,288 to Chang, et al. ("Chang"). As indicated above, claims 3-6, 17, and 23-32 were canceled. Therefore, this rejection with respect to claims 3-6, 17, and 23-32 is rendered moot. With respect to the remaining claims 1, 2, 7-10, 18, 20, and 21, this rejection is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claims 1, 2, 7-10, 18, 20, and 21, are not taught or suggested by Chang, whether taken individually or in combination with any of the other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to the claims to more clearly describe features of the present invention. Specifically, amendments were made to the claims to more clearly describe that the present invention is directed to a method for mediating an electronic payment and a system for mediating an electronic payment as recited, for example, in independent claims 1, 2, 7, and 20.

The present invention, as recited in claim 1, and as similarly recited in claims 2, 7 and 20, provides a method for mediating an electronic payment by sending and receiving electronic data. The method includes a step of sending electronic data

relating to a payment intention from a payment mediation system to a recipient system when electronic data relating to a funds payment intention is received from a payer system. The method also includes a step of requesting a deposit of funds from assets held by the payer into a deposit account of a financial system managed or owned by a financial institution determined from the electronic data relating to the payment intention. The deposit account is identified by the recipient system upon receipt of the payment intention from the payment mediation system, and provided to the payment mediation system. The payment mediation system requests the deposit of funds into the deposit account when electronic data relating to the deposit account is received from the recipient system within a payment due date or a payment period determined from the electronic data relating to the payment intention. The prior art does not disclose all these features.

The above described features of the present invention, as now more clearly recited in the claims, are not taught or suggested by any of the references of record, particularly Chang, whether taken individually or in combination with the other references of record.

Chang discloses a method and system for electronic bill payment. However, there is no teaching or suggestion in Chang of the method for mediating an electronic payment and the system for mediating an electronic payment, as recited in the claims.

Chang provides a fully automated electronic bill processing capability that is integrated with banking institutions and their customers. The bill payment system

includes a community of payors, payees, payor banks, and payee banks that are associated with computing systems interconnected by a computer network. A payor bank receives electronic bills specifying payment requests from one or more payors having an account at the payor bank. The payor bank places a hold on funds in the payor's account, and then generates an electronic check that is transmitted to the payee. The payee receives an electronic check envelope that contains a number of electronic checks that are encrypted and digitally signed by the payor bank. The payee generates an electronic deposit including one or more endorsed electronic checks and a deposit slip. The electronic deposit slip is encrypted and digitally signed by the payee. The electronic deposit is transmitted to a payee bank that the payee is associated with. The payee bank authenticates the endorsed check and credits the payee's account accordingly.

Features of the present invention, as recited in claim 1 and as similarly recited in claims 2, 7 and 20, include requesting a deposit of funds from the assets held by the payer into a deposit account of a financial system managed or owned by a financial institution determined from the electronic data relating to the payment intention. The deposit account is identified by the recipient system upon receipt of the payment intention from the payment mediation system and is provided to the payment mediation system. The payment mediation system requests the deposit of funds into the deposit account when electronic data relating to the deposit account is received from the recipient system within a payment due date or a payment period

determined from the electronic data relating to the payment intention. Chang does not disclose these features.

For example, Chang does not disclose "said deposit account being identified by the recipient system and provided to the payment mediation system upon receipt of the payment intention from the payment mediation system," as recited in claim 1, and as similarly recited in claims 2, 7 and 20. As shown in Fig. 5, Chang discloses a payor bank 206 that receives bill payment instructions 214 from a payor 202. Based on the instructions received from the payor 202, the payor bank 206 provides an electronic check 504 to the payee 208. The payee 208 then provides an electronic deposit 506 to the payee bank 206. Chang is silent as to which entity provides the deposit account information needed to provide the electronic deposit (see, e.g., column 7, lines 25-30). However, Chang clearly teaches against the deposition account being provided to the payor bank 206, or the payment mediation system, as in the present invention because it is not necessary for the payor bank 206 to have the deposit account information. Specifically, the payor bank 206 only provides the electronic check 504 to the payee 208, while the payee 208 provides the electronic deposit to the payee bank 206. A check, whether electronic or otherwise, does not include the deposit account of the payee. At most, it may be implied that the payee 208 provides deposit account information to the payee bank 206, which is not the same as the recipient system providing the deposit account information to the payment mediation system, as in the present invention.

By way of further example, Chang does not disclose “said payment mediation system requesting the deposit of funds into said deposit account when electronic data relating to said deposit account is received from said recipient system within a payment due date or a payment period determined from said electronic data relating to said payment intention,” as recited in claim 1, and as similarly recited in claims 2, 7 and 20. As described in column 7, lines 9-44, Chang discloses where the payor bank checks whether the payor’s account has sufficient funds to cover the bill payments and debits to the payor’s account. However, Chang does not disclose where the payment mediation system requests a deposit of funds when electronic data relating to the deposit account is received from the recipient system within a payment due date or a payment period determined from the electronic data relating to the payment intention, as in the present invention.

Therefore, Chang fails to teach or suggest “requesting a deposit of funds from assets held by said payer into a deposit account of a financial system managed or owned by a financial institution determined from said electronic data relating to said payment intention, said deposit account being identified by the recipient system and provided to the payment mediation system upon receipt of the payment intention from the payment mediation system, and said payment mediation system requesting the deposit of funds into said deposit account when electronic data relating to said deposit account is received from said recipient system within a payment due date or a payment period determined from said electronic data relating to said payment intention” as recited in claim 1.

Furthermore, Chang fails to teach or suggest “requesting a deposit of funds as indicated by the payer into a deposit account of a financial institution determined from said payment intention when a deposit account identification is received from said recipient by said mediator within a payment due date or a payment period determined from said payment intention for each payment, said mediator requesting the deposit of funds into said deposit account” as recited in claim 2.

Even further, Chang fails to teach or suggest “a periodic processing means for determining electronic data relating to the deposit account identification received within a payment period or a payment due data indicated in the electronic data relating to the payment intention, and for requesting a deposit of funds from the assets held by the payer into the determined deposit account of a financial system managed or owned by a financial institute indicated in said electronic data relating to said payment intention” as recited in claim 7.

Still even further, Chang fails to teach or suggest “a deposit account registration processing means for sending electronic data relating to the payment intention to a recipient system belonging to a funds recipient, for receiving electronic data relating to deposit account identification from the recipient system within a payment due date or a payment period indicated in said electronic data relating to said payment intention, and for registering the deposit account and information indicating that funds are unpaid in a payment status field in a database” and “a periodic processing means for searching the database for a deposit account associated with the payment status indicating funds are unpaid and for requesting a

deposit of funds from assets held by the payer into the deposit account of a financial system managed or owned by a financial institution indicated in said electronic data relating to said payment intention” as recited in claim 20.

Therefore, Chang fails to teach or suggest the features of the present invention, as now more clearly recited in the claims. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §102(a) rejection of claims 1, 2, 7-10, 18, 20, and 21 are respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 1, 2, 7-10, 18, 20, and 21.

35 U.S.C. §103 Rejections

Claims 11-16

Claims 11-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chang in view of U.S. Patent No. 6,049,786 to Smorodinsky. This rejection is traversed for the following reasons. Applicants submit that claims 11-16 are dependent on claim 7. Therefore, claims 11-16 are allowable for at least the same reasons discussed previously regarding independent claim 7. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Claim 19

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chang in view of U.S. Patent No. 6,067,621 to Yu. This rejection is traversed for the

following reasons. Applicants submit that claim 19 is dependent on claim 7. Therefore, claim 9 is allowable for at least the same reasons discussed previously regarding independent claim 7. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Claim 22

Claim stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chang. This rejection is traversed for the following reasons. Applicants submit that claim 22 is dependent on claim 20. Therefore, claim 20 is allowable for at least the same reasons discussed previously regarding independent claim 20. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

New Claims 33-36

Claims 33 and 34 are dependent on claim 1, and claims 35 and 36 are dependent on claim 7. Therefore, Applicants submit that claims 33-36 are allowable for at least the same reasons previously discussed regarding independent claims 1 and 7.

In view of the foregoing amendments and remarks, Applicants submit that claims 1, 2, 7-16, 18-22, and 33-36 are in condition for allowance. Accordingly, early allowance of claims 1, 2, 7-16, 18-22, and 33-36 is respectfully requested.


To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the

U.S. Application No. 09/803,208

deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. 501.41883X00).

Respectfully submitted,

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